

REMARKS

Reconsideration of the instant application is respectfully requested. The present submission is provided in conjunction with a Request for Continued Examination (RCE), pursuant to 37 CFR 1.114 and a Declaration pursuant to 37 CFR 1.131, copies of which are enclosed. The RCE is submitted in response to the Final Office Action of January 15, 2004, and in view of the Advisory Action of March 25, 2004 in which claims 14-20 stand rejected under 35 USC §103(a), as being allegedly unpatentable over U.S. Patent Application Publication No. US 2002/0188513A1 to Gil et al. in view of U.S. Patent Application Publication No. US 2003/0126000A1 to Clendenin. The Applicants swear behind the Gil reference and submit herewith a Declaration pursuant to 37 CFR 1.131 in support (with dates redacted). Accordingly, the Applicants submit that the instant application is patentable over the Gil reference rendering moot the outstanding rejections of claims 14-20. For at least this reason, it is respectfully submitted that the application is now in condition for allowance.

Claim Rejections - 35 USC § 103

Claims 14-20 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Gil in view of Clendenin. Specifically, the Examiner asserts that Gil discloses or inherently teaches all of the limitations of the Applicants claims except the specifics of the network configuration. The Examiner further asserts that Clendenin discloses a similar network system and further teaches the specific hardware associated with the network. As a result, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gil to use specific types of hardware to make up the network system, in view of Clendenin, in order to allow small-to-medium sized businesses into the network while keeping costs low. The Applicants respectfully disagree.

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For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

This rejection is respectfully traversed for the following reasons. The prior art references relied upon by the Examiner do not teach or suggest all of the claim limitations. See MPEP § 2143. Specifically, the references neither teach nor suggest "(a) system for facilitating supply chain processes in an outsourced manufacturing environment, comprising:

a manufacturing entity comprising:

a server;

an outsourced supply chain tool executing on said server;

a terminal in communication with said server via a communications link;

a data storage device in communication with said server via said communications link;

a network link to at least one contract manufacturer system;

a network link to a customer focus team system, said customer focus team system performing administrative services for said at least one contract manufacturing system on behalf of said manufacturing entity;

wherein said administrative services include at least one of:

facilitating transfer and replenishment of components needed during manufacture;

ensuring ongoing inventory demand issues are addressed and resolved;

obtaining and providing metrics on outsourced supply chain parts and

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activities;

assisting said at least one contract manufacturing system during shortfalls of supplies;

collaborating with said commodity team council systems relating to acquisition of critical parts; and

providing assistance on matters related to import, export, and tax issues."

The Examiner asserts that the Gil reference discloses or inherently teaches all of the limitations of the Applicants amended claims. In fact, the Examiner fails to point out a single element recited in Applicants' claims that is disclosed in Gil. Rather, the Examiner makes a blanket assertion that Gil teaches that a "network system may include for each partner, a subsystem which is physically located at the partner's site; whereby the subsystem allows integration of the diverse partner domains with the enterprise domain" (Final Office Action, January 15, 2004). While the Examiner may be correct in stating that diverse partner domains may be integrated with an enterprise domain (Gil, paragraph 0050), this does not reconcile Gil with the instant application as the administrative functions performed, as well as the defined customer focus team entity defined in the present application, do not comport with the functions of the domains suggested by Gil.

The Examiner provided rationale that "(i)t is well known that a business entity's 'diverse' domains may include the administrative staff. The 'administrative services', as claimed, are well known services performed by entities in business." The diverse domains recited in Gil include "a network domains 14, one or more enterprise domains 16, one or more partner domains 18, and a customer domain 20" (Gil paragraph 0040).

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The enterprise domain in Gil is defined as "a manufacturer of goods, such as an original equipment manufacturer (OEM), or a provider of services to businesses or consumers buying products from OEM companies, such as an electrical utility or a telecommunications company" (Gil paragraph 0043). A partner domain is defined in Gil as "a supplier of raw materials or parts, a third party logistics (3PL) vendor such as a warehouse hub, a carrier, or a service provider, a third party maintainer (3PM) such as a field service, third party repair center, third party returns handling center, or a third party fulfillment provider such as a distributor" (Gil paragraph 0043). A customer domain as recited in Gil "may purchase goods or services from the enterprise" (Gil paragraph 0043). The customer focus team recited in Applicants' claim 14 is not equivalent to any of the domains recited in the Gil reference. The administrative functions, as provided in claim 14, are performed by the customer focus team for a contract manufacturer on behalf of the manufacturing entity. These functions are not equivalent to those recited above with respect to the Gil reference. Thus, the Gil reference does not disclose or inherently teach each of the limitations set forth in the Applicants amended claims. Accordingly, the Applicants submit that the Gil reference has been misapplied with respect to the instant application. The Applicants respectfully request that the rejections be withdrawn.

Notwithstanding the above, the Applicants have filed concurrently herewith a Declaration under 37 CFR 1.131 to overcome the outstanding rejections based upon the Gil reference. The Declaration includes Exhibits A through E that support the Applicants' conception and reduction to practice of the features as recited in claim 14, which antedate June 8, 2001, the date of the Gil reference. For at least this reason,

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Applicants submit that claim 14 is patentable over Gil.

Regarding Applicants' claims 15-20, the Examiner further asserts that the limitations associated with the claims would have been obvious design choices to one of ordinary skill in the art at the time of the invention and submits that these limitations are coherent with normal and well known business practices to produce a desired result. This type of "design choice" rejection has been criticized by the Court of Appeals for the Federal Circuit. In the case of *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1995) (citing *In re Gal*, 25 USPQ2d 1076 (Fed. Cir. 1992)), the Federal Circuit reversed a Board of Appeals rejection based on design choice and held that a "finding of 'obvious design choice' precluded where the claimed structure and the function it performs are different from the prior art." In *In re Gal*, 25 USPQ2d 1076, 1078-79 (1992), the court held that the design of each of the layers of an integrated semiconductor chip was not an obvious design choice. In particular, the court held Gal's semiconductor chip was different from the prior art and that the Board had ignored the claimed structure and the functions it performs.

In the present case, Applicants claim 15 recites a link to both a supplier system and a commodity council team system, whereby the commodity council team system provides administrative support to the supplier system including at least one of:

- "ensuring timely placement of purchase orders relating to supporting supplier systems;
- managing order books of said supporting supplier systems;
- providing outsourced supply chain metrics relating to supply chain activities;
- escalating shortfalls identified for inventories of said supplier systems;
- assisting said customer focus team systems in acquiring critical parts;
- facilitating replenishment implementation and drive to complete

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drop shipment functions;

resolving finance issues;

visiting said supplier systems;

providing support for other outsourced supply chain regions on unique supplier issues;

providing input on supplier report cards; and

interfacing with council chairs on contract issues, geographical allocations, supplier credits, and letters to suppliers on transfers."

The commodity council team structure recited in the instant application is not provided in the references submitted by the Examiner. Further, the administrative support provided by the commodity council team to the supplier system, as indicated above with respect to claim 15, include functions not recited in the references submitted by the Examiner. Accordingly, because the claimed structures and their corresponding functions are not the same as what is taught in the cited art references, the limitations recited in amended claim 15 are not coherent with normal and well known business practices and would not be an obvious design choice to one of ordinary skill in the art. Applicants respectfully request reconsideration of the rejection of claim 15. Claims 16-20 depend from what is an allowable claim 15. Claim 15 depends from what is an allowable claim 14. For at least these reasons, the Applicants submit that claims 14-20 are in condition for allowance and request reconsideration of the outstanding rejections.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

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In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 09-0458.

Respectfully submitted,

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